

REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. Reconsideration of the application in light of the following remarks is respectfully requested.

Rejections

Request for Withdrawal of Finality

As a preliminary matter, there are several reasons why Applicants respectfully believe that the final rejections of independent claims 11, 27, 35, 37, and 41 are deficient on their face and should be withdrawn.

In the previous response, Applicants amended a limitation common to all these claims from "the folder associated with the date" to "the folder having a folder name indicative of the date" (emphasis added). However, the final rejections of independent claims 11, 37, and 41 reference the original, unamended language and thus fail to address the amendments Applicants made in the previous response. Applicants are entitled to consideration of claim amendments made in response to a non-final rejection, and believe that such consideration was not given by the Office in regard to at least independent claims 11, 37, and 41.

Further, while independent claims 11, 35, 37, and 41 were rejected under 35 USC §103(a) as being unpatentable over U.S. patent application publication 2002/0097452 to Nagarajan ("Nagarajan") in view of U.S. patent 6,034,785 to Itoh ("Itoh"), the rejections do not specify how the Itoh reference is applied to any of these claims.

In addition, the Final Office Action contains two separate rejections for independent claim 27. Because the second claim 27 rejection (Final Office Action, p.10) is identical to the rejection of the prior Non-final Office Action, the first claim 27 rejection (Final Office Action,

p.9) is the one traversed herein.

In the absence of conditions such as misjoinder or fundamental defects in the application (conditions which do not exist here), 37 C.F.R. §1.104(b) requires that the “examiner’s action will be complete as to all matters”. For the reasons stated above that render the final rejection deficient on its face, Applicant believes that the Final Office Action is not complete. Accordingly, Applicant respectfully requests that the finality of the present rejection be reconsidered and withdrawn.

Rejection Under 35USC §103

Claims 1-9, 11-25, 27-38, and 41 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent application publication 2002/0097452 to Nagarajan ("Nagarajan") in view of U.S. patent 6,034,785 to Itoh ("Itoh"). Applicants respectfully traverse the rejection and request reconsideration.

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant’s disclosure.

The rejection of independent claim 11, and its dependent claims 12-25, is respectfully traversed for at least the following reasons. Claim 11 recites:

“11. (Previously presented) A method of automatically organizing digital images, comprising:

acquiring a digital image from an image source;
automatically associating a date with the digital image;
automatically converting the digital image into a data file; and
storing the data file into a folder of a file system, the folder having a folder name indicative of the date.” (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant’s claim limitations.

There is no teaching or suggestion in either the Nagarajan reference or the Itoh reference, taken alone or in combination, of storing the data file into a folder of a file system, where the folder has a folder name that is indicative of a date that is associated with the digital image. With regard to this feature, it can be seen in Fig. 3 of the present application, for example, that folder 42a has a folder name of “Jul 2001”, and that folder 42b has a folder name of “Aug 2001”. As explained with reference to Figs. 3 and 4:

“At 108, the data file is stored into a data folder, such as folder 42, of a file system 40. The folder 42 is associated with the date, and typically selected from a set of data folders. If no folder 42 associated with the date as yet exists on the file system 40, such a folder 42 is created. In the preferred embodiment, the data folder is associated with a particular month and year, such as folder 42a for July 2001 and folder 42b for August 2001. For example, for a particular digital image that has a capture date of Jul. 15, 2001 and a storage date of Aug. 23, 2001, if the associated date is the capture date, the image file will be stored into the July 2001 folder 42a, alternatively, if the associated date is the storage date, the image file will be stored into the August 2001 folder 42b. Such a folder organization advantageously organizes the digital images by date, thus helping the user to easily and quickly locate desired images for viewing or post-processing.” (p.11, lines 10-20)

In the rejection of claim 11, the Office states that the Nagarajan reference teaches “storing the data file into a folder of a file system, the folder associated with the data (the overall function of the imaging system 30 of fig 1, controlled by computing unit 110 of fig 1, including storing

data file)" (Final Office Action, p.6; emphasis added). The pertinence of imaging system 30 and/or computing unit 110 to the limitation of "storing the data file into a folder of a file system, the folder having a folder name indicative of the date" is unclear. Nowhere in Fig. 1, or anywhere else in the Nagarajan reference, is a file system folder name disclosed in any form, much less as being a folder name indicative of a date automatically associated with the digital image.

It is noted that independent claims 27, 35, 37, and 41 each recite a similar limitation. In rejecting various ones of these claims, the Office cites with regard to this limitation that "memory 100 store data file into a data folder, computer 50 associate with date" (claim 35); "memory 100 of fig 1 stores data file" (claim 37); "image file are stored in the memory 100 of fig 1" (claim 41). In rejecting claim 27, the Office refers to col. 2, paragraph [0018], lines 5-9, of the Nagarajan reference, which discloses

"In addition computing unit 110 is connected to the scanning unit 20 and the image processing unit 70 by way of a control/data bus. In this manner computing unit 110 controls the overall functioning of the system 30 and the flow of image data through the various components."

Again, the pertinence of these aspects of the Nagarajan reference is unclear, in that nowhere do these aspects disclose a file system folder name indicative of a date automatically associated with the digital image, as recited in claim 11.

Nor does the Itoh reference remedy the deficiencies of the Nagarajan reference. The Itoh reference is directed to

"a picture postcard such as a New Year's card and the like, in which a customer's recorded image, a background image having a picture associated with the New Year's greetings, predetermined characters and predetermined sentences such as "Happy New Year", "Greeting" and the like associated with the New Year's greetings, and characters such as the address, name and arbitrarily-created sentence and the like of a customer are synthesized, is used as a typical example of a subject to which the image synthesizing method of the present invention is applied." (col. 1, lines 5-13)

The Itoh reference discloses scanning the image data of an original and storing it in memory (col. 9, line 66 – col. 4, line 4). However, nowhere in the Itoh reference is a file system

folder name for the scanned image data disclosed in any form, much less as indicative of a date automatically associated with the digital image. It is noted that the Office does not cite the Itoh reference as teaching or suggesting this limitation.

Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings. While it is noted that no specific reference to the Itoh reference is made in the rejection of either claim 11, or similar independent claims 35, 37, or 41, the Office does state with reference to similar independent claim 27 that it would have been obvious to combine the references “for the purpose wasting little time in the processing of image data by automatically controlling the productivity of the output of the image to increase productivity” (Final Office Action, p.10). Applicants believe that the stated motivation consists merely of a conclusory statement of generalized advantages and convenient assumptions which is too vague and not specific enough to ascertain a motivation in one reference or the other for combining them. Consequently, using these conclusory statements to create the limitations of claim 11 impermissibly uses Applicants’ disclosure as a blueprint in hindsight for the rejection. Because there is no credible motivation or suggestion to combine provided by the Office, it is improper to combine the Nagarajan and Itoh references.

In addition, the Nagarajan reference teaches away from combining with the Itoh reference. The Nagarajan reference teaches that the recommended settings for image mode and image parameters generated by the scanning system are intended to assist a user in adjusting the settings to match the original document (Abstract), not replace the user. Such document image matching is often a subjective exercise best suited to the eye of a human observer, and so “the user has the option to adopt the recommended settings” (para. [0008]). However, if any features in the Itoh reference allow the scanning to be performed automatically without user confirmation, the benefits of confirmation by the eye of a human observer that the recommended settings are desirable would be disadvantageously lost. This further indicates lack of motivation to combine the references, in that the combination must not merely be feasible, but also desirable. “Trade-

offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter" *Winner Int'l Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1587. Applicant believes that the loss of user confirmation of the appropriateness of the recommended image settings that would result from combining the Nagarajan and Itoh references, assuming arguendo that such a combination is feasible, is not desirable on balance and is therefore impermissible.

The features of the present invention are neither disclosed nor suggested by the Nagarajan reference in combination with the Itoh reference. In addition, the Itoh reference is not properly combinable with the Nagarajan reference, and the Nagarajan reference teaches away from such a combination. Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claims 27, 35, 37, and 41 each recite limitations similar to those of claim 11, discussed above. For similar reasons as explained heretofore with regard to claim 11, the features of the present invention are not taught or suggested by the cited references in that the features by which digital image is stored into a file system folder having a folder name indicative of a date that is associated with the digital image are neither taught nor suggested by the Nagarajan reference in combination with the Itoh reference. Also for similar reasons as explained with regard to claim 11, the Itoh reference is not properly combinable with the Nagarajan reference, and the Nagarajan reference teaches away from such a combination.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection of independent claims 27, 35, 37, and 41, and their corresponding dependent claims 28-34, is improper at least for that reason and should be

withdrawn.

The rejection of independent claim 1, and its dependent claims 2-9, is respectfully traversed for at least the following reasons. Claim 1 recites:

“1. (Previously presented) A method of optically scanning a target item, comprising: configuring an optical scanning arrangement with predefined settings for scanning parameters appropriate to a photographic image;
initiating a scanning operation;
in response to the initiating, optically scanning the target item using the predefined settings to form a digital image of the target item; and
converting the digital image into a data file, wherein the scanning and the converting are performed automatically without intervention by a user, and wherein the predefined settings are not defined by the user.” (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant’s claim limitations.

The Office admits that “Nagarajan does not expressly teach converting the digital image into a data file, wherein the scanning, and the converting are performed automatically without intervention by the user, and wherein the predefined setting are not defined by the user” (Final Office Action, p.3). However, the Office further states that the Itoh reference teaches these limitations.

Applicants disagree. The picture postcard creating system of the Itoh reference synthesizes a picture postcard image from a scanned image of an original, a background image, and greeting text. It is readily apparent upon examination of the specification that the scanning and converting are performed with the intervention of a user (i.e. an operator) rather than automatically, and that the user defines the predefined settings for the scanning parameters. With regard to the flowchart of Fig. 4 of the Itoh reference, a job file is created in memory, and an operator provides (i.e. by designating on a monitor) parameters for the job, including a print magnification setting to be used for scanning the image (col. 13, lines 35-50). The print magnification setting chosen by the operator is stored in a “PtintMag” parameter in a scan section

(Table 3, cols. 33-34) of the job file. The Itoh reference further discloses that

“a position and a size of a read image (hereinafter, referred to as a scanned image) on a template image are previously designated for each scanned image ... As a result, respective scan images are read by the scanner 12 in response to the designation from the customer's original in accordance with a designated size at the subsequent image scan process F2. The respective scan images having been read are converted into image data having an output resolution of a designated size, for example, 300 dpi” (col. 13, line 60 – col. 14, line 5; emphasis added)

Therefore, the features of the present invention are neither disclosed nor suggested by the Nagarajan reference in combination with the Itoh reference in that the limitations of the scanning and the converting being performed automatically without intervention by a user, and wherein the predefined settings for the scanning parameters are not defined by the user, are neither taught nor suggested by the combined references.

Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings. The Office states that it would have been obvious to combine the references “for the purpose of obtaining a perfect final image, for all the prints of different color to be exactly superimpose” (Final Office Action, p.4). Applicants believe that the stated motivation consists merely of a conclusory statement of generalized advantages which is too vague and not specific enough to ascertain a motivation in one or the other reference for combining them. Consequently, using these conclusory statements to create the limitations of claim 1 impermissibly uses Applicants' disclosure as a blueprint in hindsight for the rejection. Because there is no credible motivation or suggestion to combine provided by the Office, it is improper to combine the Nagarajan and Itoh references.

In addition, and for similar reasons as explained heretofore with reference to claim 11, the Nagarajan reference teaches away from combining with the Itoh reference in that the loss of user confirmation of the appropriateness of the recommended image settings that would result from combining the Nagarajan and Itoh references, assuming arguendo that such a combination is feasible, is not desirable on balance and is therefore impermissible.

The features of the present invention are neither disclosed nor suggested by the Nagarajan reference in combination with the Itoh reference. In addition, the Itoh reference is not properly combinable with the Nagarajan reference, and the Nagarajan reference teaches away from such a combination. Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claims 36 and 38 each recite limitations similar to those of claim 1, discussed above. For similar reasons as explained heretofore with regard to claim 1, the features of the present invention are not taught or suggested by the cited references in that the features by which, without user intervention, a target item is optically scanned using predefined settings for scanning parameters and converted into a data file are neither taught nor suggested by the Nagarajan reference in combination with the Itoh reference. Also for similar reasons as explained with regard to claim 1, the Itoh reference is not properly combinable with the Nagarajan reference, and the Nagarajan reference teaches away from such a combination.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection of independent claims 36 and 38 is improper at least for that reason and should be withdrawn.

Conclusion

Attorney for Applicant(s) has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application

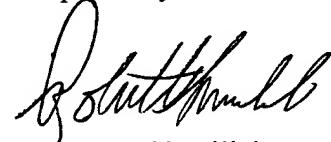
patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

**AUTHORIZATION TO PAY AND PETITION
FOR THE ACCEPTANCE OF ANY NECESSARY FEES**

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



Robert C. Sismilich
Reg. No. 41,314
Attorney for Applicant(s)
Telephone: (858) 547-9803

Date: 5/19/06

Hewlett-Packard Company
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400